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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,221	01/21/2004	Kia Silverbrook	SMA06US	1369
24011	7590	12/15/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			COLILLA, DANIEL JAMES	
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/760,221	<b>Applicant(s)</b> SILVERBROOK ET AL.	
	<b>Examiner</b> Daniel J. Colilla	<b>Art Unit</b> 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15, 18-21, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 14, 16, 17 and 22-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/3/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "89" and "98" have both been used to designate the sliding door as shown in Figures 15 and 16 . Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claims 3-26 are objected to because of the following informalities:

In claims 3-26, the preamble of the claims do not match that of the parent claims 1 and 2.

In claim 18, line 4, it appears that "removable" should actually be --removably-- for proper grammar.

Appropriate correction is required.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/760,220.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of Application 10/760,220 recites all the structure recited in claims 1-5 of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 6 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 10/760,220.

Although the conflicting claims are not identical, they are not patentably distinct from each other

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because claim 5 of Application 10/760,220 recites all the structure recited in claim 6 of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 1 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 16 of copending Application No. 10/760,237.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 16 of Application 10/760,237 recites all the structure recited in claim 1 of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claim 1 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 16 of copending Application No. 10/760,180.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 16 of Application 10/760,180 recites all the structure recited in claim 1 of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claim 1 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 10/760,252.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 17 of Application 10/760,252 recites all the structure recited in claim 1 of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/760,265 in view of Koike et al. (US 6,733,197). Claim 1 of Application NO. 10/760,265 recites all the structure recited in claim 1 of the present application except for the slitter means. However, Koike et al. teaches a photofinishing system including slitter means 58 located in series with a printer 46 as shown in Figure 2 of Koike et al. It would have been obvious to combine the teaching of Koike et al. with the photofinishing system disclosed by Koike et al. for the advantage of being able to divide up the full width of the print media in order to make smaller sizes of photos.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-2 and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Koike et al. (US 6,733,197).

With respect to claim 1, Koike et al. discloses a photofinishing system (col. 6, lines 19-31), including a printer 46, means 63 for feeding print media from a roll 62 and a slitter 58 as shown in Figure 2 of Koike et al. Koike further discloses a film scanner 12 that digitizes a photographic image from the film and thereby creating a drive signal that is representative of a photographic image. Also disclosed is a processor 42 for generating the drive signal that is representative of the photographic image to be printed as shown in Figure 1 of Koike et al.

With respect to claim 2, the processor 42 is a digital processor arranged to receive digitized data and to process the data in a manner to generate a printer drive signal (this is inherent in the definition of a printer processor). Koike further discloses that the printer 46 prints in a page-width manner as can be seen by the length of the printer 46 in Figure 2.

With respect to claim 8, Koike et al. discloses inputting the image with an input source 12 which is a scanning device (Koike et al., col. 6, lines 32-38).

With respect to claim 9, the system disclosed by Koike et al. is capable carrying out the method steps recited in this claim.

With respect to claim 10, the printer 46 disclosed by Koike et al. is a recording head assembly.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3-7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koike et al. (US 6,733,197) as applied to claim 2 above, and further in view of Silverbrook et al. (US 6,238,044).

With respect to claim 3, Koike et al. discloses the claimed photofinishing system except that he is silent on whether the print media is provided by way of a replaceable cartridge.

However, Silverbrook et al. teaches a replaceable print media cartridge 10 that can be used with a printer. It would have been obvious to combine the teaching of Silverbrook et al. with the photofinishing system disclosed by Koike et al. for the advantage of an easily replaceable paper and ink supply that can be replaced by removing just one cartridge.

With respect to claim 4, the paper roll 62 disclosed by Koike et al. is juxtaposition to the printer 64 and the and the cartridge taught by Silverbrook et al. includes a means 56 for coupling with a print media feed drive.

With respect to claim 5, Silverbrook et al. teaches a replaceable printing fluid cartridge 58 as shown in Figure 2 of Silverbrook et al.

With respect to claim 6, Silverbrook et al. teaches a primary cartridge 10 and Koike et al. teaches a paper roll 62 arranged in juxtaposition to a printer 46. Silverbrook et al. teaches that a roll of print media 30 is housed in the cartridge and includes a means 56 for coupling with a print media feed drive mechanism. Additionally, Silverbrook et al. teaches a refillable secondary cartridge 58 carried by the primary cartridge 10 as shown in Figure 3 of Silverbrook et al.



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With respect to claim 7, Silverbrook et al. teaches that the roll of print media 30 is removably mounted on a tubular core 28 of the primary cartridge 10 as shown in figure 3 of Silverbrook et al.

With respect to claim 18, although not shown by Koike et al., a support structure is inherent in the disclosed photofinishing system because the structure shown in Figure 2 of Koike et al. cannot hang in mid-air. Silverbrook et al. teaches a cartridge 10 containing a replaceable roll of print media that can be removably mounted to a printer structure.

14. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koike et al. (US 6,733,197) as applied to claim 10 above, and further in view of Nishikawa et al. (JP 2000-272111).

With respect to claim 11, Koike et al. discloses the claimed photofinishing system except for the two confronting, spaced-apart print head assemblies. However, Nishikawa et al. teaches a printer with two confronting, spaced-apart print head assemblies 107 and 109 as shown in Figure 1 of Nishikawa et al. It would have been obvious to combine the teaching of Nishikawa et al. with the photofinishing system disclosed by Koike et al. for the advantage of printing on both sides of the print media.

With respect to claim 12, the structure disclosed by Koike et al. is capable of selectively printing onto at least one face of print media from the roll of print media.

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15. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koike et al. (US 6,733,197) in view of Nishikawa et al. (JP 2000-272111), as applied to claim 11 above, and further in view of Silverbrook et al. (US 6,609,787).

Koike et al. in view of Nishikawa et al. discloses the claimed photofinishing system as mentioned above except for the specifics of the print head assembly. However, Silverbrook et al. teaches a print head assembly having at least one print head module 10 which comprises a unitary arrangement of a support member 14 and at least four micro-electromechanical integrated circuit print head chips 18 (each with a plurality of nozzles 42) as shown in Figure 5 of Silverbrook et al. Further taught by Silverbrook et al. is a fluid distribution arrangement 32 mounting each of the print head chips 18 to the support member 14 and a connector 56 for connecting electrical power and signals to each of the print head chips 18 as shown in Figure 5 of Silverbrook et al.

16. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koike et al. (US 6,733,197), as applied to claim 2 above, and further in view of Ishii et al. (JP 2003-54044).

Koike et al. discloses the claimed photofinishing system except that he is silent on whether the drier means 50 has guide rollers. Koike et al. discloses a drier means 50 arranged directly after the printer and includes a blower arranged to direct drying air onto at least one face of the print media (Koike et al. ,col. 13, lines 31-40). Ishii et al. teaches a printer with a drier 50 including guide rollers 82 and 84 as shown in Figure 2 of Ishii et al. It would have been obvious to combine the teaching of Ishii et al. with the photofinishing system disclosed by Koike

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et al. for the advantage of providing positive feeding force to the media as it passes through the drier.

17. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koike et al. (US 6,733,197) as applied to claim 2 above, and further in view of Silverbrook et al. (US 2002/0093569).

With respect to claim 18, Koike et al. discloses the claimed photofinishing system except for the cartridge containing a replaceable roll of print media. Although not shown by Koike et al., a support structure is inherent in the disclosed photofinishing system because the structure shown in Figure 2 of Koike et al. cannot hang in mid-air. However, Silverbrook et al. discloses a printer with a cartridge 504 containing a replaceable roll of print media as shown in Figure 5 of Silverbrook et al. . It would have been obvious to combine the teaching of Silverbrook et al. with the photofinishing system disclosed by Koike et al. for the advantage of an easily replaceable paper and ink supply that can be replaced by removing just one cartridge.

With respect to claim 19, Figure 13 of Silverbrook et al. teaches a support structure that includes a compartment for removably locating the cartridge 504.

With respect to claim 20, Silverbrook et al. teaches a feed means 536 located in the cartridge 504, and a drive means 530 provided on the support structure. Silverbrook et al. further discloses that the drive means 530 is coupled to the feed means 536 through gearing and element 540 as shown in Figure 2 of Silverbrook et al.

With respect to claim 21 Silverbrook et al. discloses a paper feed drive mechanism 530 mounted to the compartment and arranged to engage a roll of print media in cartridge 504.

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18. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koike et al. (US 6,733,197) in view of Nishikawa et al. (JP 2000-272111) and Silverbrook et al. (US 6,609,787), as applied to claim 13 above and further in view of Otani et al. (US 6,106,094).

With respect to claim 25, Koike et al. in view of Nishikawa et al. and Silverbrook et al. disclose the claimed photofinishing system except for the recited speed of printing. However, Otani et al. teaches that it is known to print at speeds of 5 meters per second (Otani et al., col. 1, lines 22-28). It would have been obvious to combine the teaching of Otani et al. with the photofinishing system disclosed by Koike et al. in view of Nishikawa et al. and Silverbrook et al. for the advantage of the faster printing speed.

With respect to claim 26, the exact number of chips in the print head assembly and length of print head assembly would have been obvious to one of ordinary skill in the art through routine experimentation.

***Allowable Subject Matter***

19. Claims 14, 16-17 and 22-24 are objected to as being dependent upon a rejected base claim and objected to for the above mentioned informalities, but would be allowable if rewritten in independent form including all of the limitations of their respective base claims and any intervening claims and rewritten to overcome the informalities.

20. The following is a statement of reasons for the indication of allowable subject matter:

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Claim 14 has been indicated as containing allowable subject matter primarily for the print head module being removably located in a channel portion of a casing.

Claims 16-17 have been indicated as containing allowable subject matter primarily for the guide rollers and the rotatably, selectively positional turret supporting the rotatable shafts.

Claims 22-23 have been indicated as containing allowable subject matter primarily for the door provided in a wall portion of the cartridge.


Claim 24 has been indicated as containing allowable subject matter primarily for the third drive motor which is mounted to the support structure.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 8, 2005

  
Daniel J. Colilla  
Primary Examiner  
Art Unit 2854